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| 09/725,215 | 11/29/2000 | Kazuo Sasaki | 1405.1028/JDH | 6349 |

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| EXAMINER |
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VU, THONG H

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| ART UNIT | PAPER NUMBER |
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2142

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,215

Applicant(s)

SASAKI ET AL.

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. Claims 2-8,10-13 are pending.

Response to Arguments

2. Amendment filed on 7/25/05 has been entered. Applicant's arguments with respect to claims 2-8,10-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. Claims 10-12 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility.

The user-status candidates defined is not supported in specification.

Claims 10-12 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

4. Claims 10-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.(i.e.: user-status candidates defined is not supported in specification).

Art Unit: 2142

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-8,10-13 are rejected under the judicially created doctrine of double patenting over claim 1-20 of U. S. Patent No. 6,735,615 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Both inventions disclose a Chat system monitors, notifies (i.e.: message string or notification) and displays the changed of status table to the user.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-8,10-13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gudjonsson et al [Gudjonsson 6,564,261 B1].

6. As per claim 10, Gudjonsson discloses a user-status setting method in which a user terminal can send, receive, and display a user status and a character message on at least one virtual space shared on a network [Gudjonsson, chat session, col 1 lines 32-38; message string, col 22 lines 40-42; user statuscol 3 lines 38-45] the method comprising:

storing a plurality of user-status-selection tables including a selectable list of user-status candidates defined for each virtual space in which a user participates [Gudjonsson, the buddy list, col 3 lines 37-45; database, col 12 lines 42-54];

reading out the user-status-selection table of a virtual space in which a user terminal participates when the user terminal has participated in a plurality of virtual spaces [Gudjonsson, the buddy list, user' status(es) changes, col 3 lines 37-45; col 11 line 52; select contact from the list, col 12 lines 55-67];

displaying on the user terminal the list of the selectable user statuses for each virtual space based on the read-out user-status-selection table [Gudjonsson, online statuses, col 12 lines 5-15];

setting a user status which was selected from the list of selectable user statuses for each virtual space in which the user has participated [Gudjonsson, setting on line status, col 26 lines 30-37];

sending to each virtual space the set user status, receiving from each virtual space the set user status, and displaying the set user status for each virtual space [Gudjonsson, online statuses, defining folder, different display modes, col 12 lines 5-15].

7. Claims 11,12 contain the similar limitations set forth of apparatus claim 10. Therefore, claims 11,12 are rejected for the similar rationale set forth in claim 10.

8. As per claim 2, Gudjonsson discloses user status data and a user attribute defining a configurable user statuses are correlatively registered in the status table [Gudjonsson, user registered, col 14 lines 1-10].

9. As per claim 3, Gudjonsson discloses a common table in which prescribed user statuses are registered is previously prepared, and said common table is obtained if no status table is prepared for a virtual space in which user terminals participate, and a user status on said virtual space is set for the virtual space based on an obtained

Art Unit: 2142

common table [Gudjonsson, by default, col 8 lines 47-65; col 35 lines 37-45; col 36 lines 7-21].

10. As per claim 4, Gudjonsson discloses the setting of a user status by a user is accepted [Gudjonsson, setting on line status, col 26 lines 30-37].

11. As per claim 5, Gudjonsson discloses said user terminal can display a user status with a symbol, the user status and the symbol are correlatively registered in a status table, and a status of another user sharing a virtual space is displayed with a symbol relating to the user status [Gudjonsson, symbols, col 29 lines 1-23].

12. As per claim 6, Gudjonsson discloses a list of user statuses registered in an obtained status table is displayed independently for each virtual space in which user terminals participate, selection of any user statuses on the list is accepted for each virtual space, and a user status is set for each virtual space.

13. As per claim 7, Gudjonsson discloses a computer-readable recording medium having a status setting module [Gudjonsson, database, col 12 lines 42-54].

14. As per claim 8, Gudjonsson discloses a transmission medium transmitting a status setting module [Gudjonsson, communication medium, col 16 lines 48-67].

Art Unit: 2142

15. As per claim 13, Gudjonsson discloses the user status includes a string of characters entered by the user [Gudjonsson, string, col 35 lines 13-37; character, Table 4, col 29 lines 1-23].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

